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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE PRINCE

Appeal 2008-005081
Application 09/836,890
Technology Center 2400

Decided: February 19, 2010

Before HOWARD B. BLANKENSHIP, JOHN A. JEFFERY, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-4, 6, 7, and 22. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

STATEMENT OF THE CASE

Appellant invented a system for communicating consumer-oriented information to customers in a retail environment via a computerized network

system. In one implementation, a bar code reader and a display screen are located proximate to products in a retail establishment to enable customers to (1) enter product information, and (2) display content related to the product. *See generally Abstract; Spec. 13-18; Figs. 6-7.* Claim 1 is illustrative:

1. A system for providing digital messaging services received from multiple sources over a communications network, comprising:

a client system, including:

a display screen coupled to a communications link; and

a workstation including a web browser, a user interface, a memory, and a processor, said workstation coupled to said communications link;

a hosting system, including:

a server coupled to a communications link;

a workstation for:

accessing applications stored on said server;

inputting and retrieving information stored within said hosting system, wherein said workstation is coupled to said communications link; and

a data storage device for storing data utilized by said hosting system;

wherein said hosting system is accessible to said communications network;

wherein said client system and said hosting system are in communication with each other, and wherein further, said hosting system provides digital messaging services to said client system;

an input device for entering product information and initiating selection of display-ready content related to the product from said storage device for display on said display screen;

said input device is a bar code reader and the product includes a bar code, said input device initiating selection of said display-ready content upon said bar code reader reading the bar code, said bar code reader and said display screen being located proximate to the product in a retail establishment.

The Examiner relies on the following as evidence of unpatentability:

Call	US 6,418,441 B1	July 9, 2002 (filed July 24, 2000)
Al-Kazily	US 6,760,694 B2	July 6, 2004 (filed Mar. 21, 2001)

THE REJECTIONS

1. The Examiner rejected claims 1-4, 6, and 22 under 35 U.S.C. § 102(e) as anticipated by Call. Ans. 3-6.¹
2. The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as unpatentable over Call and Al-Kazily. Ans. 6-8.

CLAIM GROUPING

Regarding the anticipation rejection, Appellant argues the following claim groupings separately: (1) claims 1-4 and 6, and (2) claim 22. *See Br. 3-5.* Accordingly, we select claim 1 as representative of the first group, and treat claim 22 separately. *See 37 C.F.R. § 41.37(c)(1)(vii).*

¹ Throughout this opinion, we refer to the Appeal Brief filed March 27, 2006 and the Examiner's Answer mailed April 7, 2008.

THE ANTICIPATION REJECTION

Regarding representative claim 1, the Examiner finds that Call discloses a digital messaging system as claimed including a display screen and a bar code reader input device that are located proximate to a product in a retail establishment. Ans. 3-5, 8, 9.

Appellant acknowledges that Call's system enables a retailer to enter a universal product code (UPC) to retrieve information about a product in connection with an inventory system. Br. 4. Appellant, however, emphasizes that the retailer's inventory system in Call is likely not positioned proximate to products in a retail establishment as claimed, but rather in a back room of the retailer. *Id.*

Regarding claim 22, Appellant argues that while Call displays product information, Call does not display information in a number of windows and alter the display of only one of the windows as claimed. Br. 5. The Examiner contends that Call alters one window at an automated check-out counter and therefore meets the claim. Ans. 9.

The issues before us, then, are as follows:

ISSUES

Under § 102, has Appellant shown that the Examiner erred by finding that Call discloses:

(1) a display screen and a bar code reader for entering product information, and initiating selecting a display-ready content related to a product, where the display screen and bar code reader are located proximate to a product in a retail establishment as recited in claim 1?

(2) displaying information in a number of windows, and altering the display of only one of the windows as recited in claim 22?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

Call

1. Call's system disseminates product information from manufacturers over the internet using existing universal product codes (bar codes) as access keys. Specifically, a cross-referencing resource (e.g., a server) (1) receives internet request messages containing all or part of a universal product code, and (2) returns the internet address at which information about the product (or the manufacturer) may be obtained. Call, Abstract.
2. To this end, a "product code translator" 101 stores cross-references between product codes and internet addresses which may be retrieved by resellers and prospective buyers (i.e., distributor 105, retailer 107, and customer 109). Call, col. 4, ll. 19-46; Fig. 1.
3. The cross-references specify the universal product codes, such as the UPC and EAN codes widely used in retail stores for barcode scanning at checkout counters, and the internet addresses where information can be obtained about the products designated by those codes. Call, col. 2, ll. 3-8.
4. The ability to obtain accurate and up-to-date product information from the manufacturer can substantially reduce the cost to resellers, catalog producers, and database vendors. Call, col. 12, ll. 39-43.

5. For example, a retailer initially creating a computerized inventory control system with previously-purchased merchandise may use a conventional hand-held barcode scanner to (1) capture the universal product codes from all goods in inventory, and then (2) retrieve complete and accurate product description records for each product via the internet using Call's invention. Call, col. 12, ll. 43-49.

6. Product information can be made available at terminals and kiosks placed in retail stores, showrooms, and public places. Call, col. 15, ll. 13-15.

7. Point of sale terminals 508² perform automated sales checkout using a bar code reader to reduce errors and speed customer checkout times. Call, col. 31, ll. 1-4; Fig. 7.

PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Appl. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

“Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted).

² Although Figure 7 denotes the point of sale terminals with numeral 505, the corresponding text in Call uses numeral 508 for these terminals. Compare Call, col. 32, l. 66 – col. 33, l. 47 with Figure 7.

ANALYSIS

Claims 1-4 and 6

We begin by noting that it is undisputed that Call discloses a display screen and a bar code reader for (1) entering product information, and (2) initiating selecting a display-ready content related to a product in connection with a retail inventory system. Appellant seemingly acknowledges this fact (Br. 4), but nonetheless contends that the retailer’s inventory system is “*more likely* not proximate to products, but rather in a back room of the retailer.” Br. 4; emphasis added.

This argument is not only speculative, but is also not commensurate with the scope of claim 1. Claim 1 merely recites that the bar code reader and display screen are “located *proximate* to the product in a retail establishment” (emphasis added). The limitation does not further limit this “proximity,” let alone require that the screen and bar code reader are located at a point of sale in the retail establishment, or otherwise accessible to customers in the establishment while shopping. In short, nothing in claim 1 precludes using a bar code reader and display in connection with an inventory system—even if used in a “back room”—so long as they are located proximate to products in the establishment.

With this construction, we find Call’s inventory system amply meets this limitation. In Call, a retailer can create a computerized inventory control system with previously-purchased merchandise by using a hand-held barcode scanner to (1) capture the universal product codes from all goods in inventory, and then (2) retrieve product description records for each product

via the internet. FF 5. This product information retrieval is facilitated by a product code translator which stores cross-references between product codes and corresponding internet addresses. FF 1-3.

Even assuming, without deciding, that this inventory is performed in a “back room” of the retail establishment as Appellant contends (Br. 4), nothing in the claim precludes this possibility. The very acts of scanning the merchandise’s bar codes and then retrieving the product description records noted above (FF 5)—even if solely for inventory purposes—would involve locating the bar code reader and the display screen proximate to those products in the retail establishment.

We acknowledge, however, that it is unclear from Call whether the bar code reader used for checkout purposes at the point of sale (FF 7) is *necessarily* used for selecting display-ready, product-related content as claimed. We reach this conclusion despite the fact that nothing in the claim precludes this display-ready, product-related content from encompassing many different types of content, including the product’s price acquired from a product’s bar code at the point of sale. Nevertheless, as noted previously, Call’s inventory system fully meets the disputed limitation of claim 1 irrespective of whether the inventory is conducted in a “back room” of the retail establishment, or in a more prominent location of the establishment. That Call indicates that product information can be made available at terminals and kiosks placed in retail stores, showrooms, and public places (FF 6) only bolsters this conclusion.

We are therefore not persuaded that the Examiner erred in rejecting representative claim 1, and claims 2-4 and 6 which fall with claim 1.

Claim 22

We will not, however, sustain the Examiner's rejection of claim 22 which calls for displaying information in a number of windows, and altering the display of only one of the windows. We find unavailing the Examiner's contention that Call alters one window of the automated check out counter and therefore meets the claim (Ans. 9).

Claim 22 recites two key features: (1) displaying information in multiple windows, and (2) altering the display of *only one* of the windows. The Examiner has failed to show that these features are necessarily present in Call, let alone the relied-upon passage pertaining to point-of-sale terminals (Ans. 9). Although the Examiner's construction is reasonable to the extent that the claim requires altering the display of one window (Ans. 9), we fail to see how this construction accounts for displaying information in *multiple* windows. Nor does this construction reasonably account for the claim's requirement of altering the display of *only one* of those windows.

As we noted previously, it is unclear from Call whether the bar code reader used for checkout purposes at the point of sale (FF 7) is *necessarily* used for selecting display-ready, product-related content as claimed, let alone displaying this content in multiple windows. And even if it did, it is hardly clear that *only one* window of this multi-window display in Call would *necessarily* be altered. *See id.* Even if it were probable that Call

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performed these functions, that would hardly mean that it is *necessarily* the case—a crucial requirement for anticipation. *See Robertson*, 169 F.3d at 745.

We are therefore persuaded that the Examiner erred in rejecting claim 22.

THE OBVIOUSNESS REJECTION

Regarding claim 7, the Examiner finds that Call discloses all claimed subject matter except for the display screen being a kiosk, and cites Al-Kazily to cure this deficiency. Ans. 6-8.

Appellant argues that while Al-Kazily obtains information over a network via a kiosk, there is insufficient motivation to combine Al-Kazily with Call since it is unlikely that Call would make proprietary inventory information available to consumers over a kiosk. Br. 5-6.

The issue before us, then, is as follows:

ISSUE

Under § 103, has Appellant shown that the Examiner erred in combining Call and Al-Kazily to arrive at the invention of claim 7? This issue turns on whether the Examiner’s reason to combine the teachings of these references supported by articulated reasoning with some rational underpinning to justify the Examiner’s obviousness conclusion.

FINDINGS OF FACT

The record supports the following additional findings of fact (FF) by a preponderance of the evidence:

Al-Kazily

8. Appellant does not dispute the Examiner's findings regarding the disclosure of Al-Kazily. *See* Br. 5 ("Al-Kazily teaches obtaining information over a network at a kiosk.").

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). If the Examiner's burden is met, the burden then shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that there was an apparent reason to combine the known elements in the fashion claimed. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417-18 (2007). Such a showing requires some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* at 418.

ANALYSIS

We will sustain the Examiner's obviousness rejection of claim 7 reciting a kiosk. Although Appellant contends that there is allegedly no

reason to provide such a kiosk in connection with Call’s inventory system which uses proprietary information (Br. 5-6), we find this argument unavailing. Not only is this contention merely speculative and predicated on the assumption that Call’s product information is proprietary (a fact that has not been established on this record in any event), Appellant’s argument is undercut by Call’s teaching that product information can be made available at kiosks. FF 6. Indeed, displaying product information publicly could very well benefit not only employees involved in an inventory, but also customers in determining whether items were available for purchase. This product information could also assist customers in their purchasing decisions. *See id.*

Although we find Al-Kazily merely cumulative to Call regarding kiosks, we nevertheless see no error in the Examiner’s reliance on Al-Kazily for teaching kiosks—a finding that is undisputed in any event (FF 8). Nor are we persuaded of error in combining this teaching with Call. For the reasons noted above, providing a kiosk in connection with Call’s inventory system has at least a rational basis to support the Examiner’s obviousness conclusion. *See KSR*, 550 U.S. at 418.³

We are therefore not persuaded that the Examiner erred in rejecting claim 7.

³ We decline to address the Examiner’s reliance on a newly-cited reference to Quinlan which is said to evidence the reason why a kiosk would be used in Call (Ans. 10). Since this reference was not cited in the rejection, we need not consider it here. *See In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970) (“Where a reference is relied upon to support a rejection, whether or not in a ‘minor capacity,’ there would appear to be no excuse for not positively including the reference in the statement of the rejection.”).

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CONCLUSION

Appellant has not shown that the Examiner erred in rejecting (1) claims 1-4 and 6 under § 102, and (2) claim 7 under § 103. Appellant, however, has shown that the Examiner erred in rejecting claim 22 under § 102.

ORDER

The Examiner's decision rejecting claims 1-4, 6, 7, and 22 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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